

REMARKS

Claims 1, 4-65 are pending in the application. Claims 1, 4-65 stand rejected by the examiner. Assignee traverses the rejections of the claims.

Examiner's Interview

Assignee's representatives would like to thank examiner Patrice Winder for the courtesies extended to assignee's representatives (John Biernacki and David Cochran) during the telephone interview on August 8, 2007. The interview discussed the specification objection and 35 U.S.C. § 112 issues. The interview also discussed the interference issue that is based upon the Ferguson reference (i.e., U.S. Patent No. 5,819,092). The remarks and the amendments contained herein further summarize the interview.

Claim Rejections - 35 U.S.C. § 112

Claims 1, 4-65 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. More specifically, the office action maintains that the specification does not provide details as to how one of ordinary skill would make a mechanism (i.e. write server scripts or configure the server) to determine the number of hits, hyperlinks, sales, and charges for advertising based on the number of hits, hyperlinks and sales. Assignee respectfully disagrees. Assignee's specification (e.g., page 14, line 16 to page 15, line 6) expressly describes the claimed features (e.g., tracking access histories, etc.) as operating within a computer server environment. In order to provide further clarification within the claims, assignee has amended independent claims 1, 4, 5, 6, 40, 41, 52, 63, 64, 65 to expressly recite that the systems and methods claimed are "computer-implemented." Thus, in view of the

amendment and above discussion, assignee respectfully requests that the instant rejections of these claims be withdrawn.

Specification Objection

Paragraph 3 of the office action objects to the amendments to the specification under 35 U.S.C. § 132(a) for introduction of new matter. While assignee respectfully disagrees with this objection, the objected-to portions of the specification have been deleted in the interests of expediting prosecution. In view of this amendment to the specification, assignee respectfully requests that the instant objection be withdrawn.

Affidavit Under 37 CFR 1.131(a)

Paragraph 5 of the office action states that an affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention and suggests that the reference can only be overcome by establishing priority of invention through interference proceedings. The office action then provides a comparison between assignee's claim 41 and claim 26 of the Ferguson reference.

However, these claims are claiming different subject matter. As a quick background of the Ferguson reference, Ferguson is directed to a "visual editing system for creating commercial online computer services." See *Ferguson Abstract* (emphasis added). Ferguson's system is made up of a series of interface screens, one of which is a fee specifier. The fee specifier feature is discussed in the specification of Ferguson under the heading "Fee Setter Introduction" which begins on line 35 of column 29.

When a claim (such as claim 26 in Ferguson) uses the term “means” to describe a limitation, a presumption inheres that the inventor used the term to invoke § 112, ¶ 6. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed.Cir. 2003). Once a conclusion is made that a claim limitation is a means-plus-function limitation, two steps of claim construction remain: 1) first identify the function of the limitation; and 2) then look to the specification and identify the corresponding structure for that function. *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed.Cir. 2003). “[T]he PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994).

Claim 26 of Ferguson claims *means* for defining at least one of a plurality of triggering actions for a fee, defining a fee specification for the entity, editing a plurality of fee specifications for the entity, and storing the plurality of fee specifications using the editing means; whereas claim 41 of the instant application claims *means* for tracking access histories, determining link traversals based on the access history, determining a number of such determined link traversals, and charging for advertising based on the number of link traversals. These claims contain significantly different functions from each other, and impart very different claimed features and structures. Because these claims recite very different features and structures, assignee respectfully maintains that Ferguson’s claim is not claiming the same patentable invention as assignee’s claim.

As another example, with respect to item (a) of claim 26 cited in the chart following paragraph 5 of the office action, the office action listed the claim of Ferguson as containing “means associated with an object of the online service for defining at least one of the plurality of triggering actions for a fee; wherein one of said user actions comprises a traverse of a hyperlink.”

With respect to this element of Ferguson, the function of this element is defining at least one of a plurality of triggering actions for a fee... The corresponding structure is the interface screen described in the specification, such as the interface screen structure discussed in column 31, line 60 to column 33, line 16 of Ferguson which is discussing Figures 23-24. This is clearly different than element (a) of claim 41 of the instant application of means for tracking access history, including a link sequence through which a document is accessed. Element (a) of claim 41 has nothing to do with a graphical interface for fee definition. Element (a) of claim 41 refers to a server tracking access history that includes the link sequence through which a document is accessed. Because these two claims are significantly different, claim 26 of Ferguson is not claiming the same patentable invention.

As another illustration of the differences, element (b) of Ferguson refers to a user screen interface for defining a fee specification. Element (c) refers to a user interface screen to provide the ability to edit the settings (e.g., see Figure 24), and element (d) refers to storing the fee specifications from the editing interface. It is clear that claim 41 of the instant application is not directed to these features or user screen interfaces for fee editing or to store such settings, and that claim 41 is claiming different subject matter (e.g., means for tracking access history including a link sequence through which a document is accessed, etc.) than claim 26 of Ferguson. Thus, it is respectfully submitted that the Ferguson reference and the instant application do not claim the same invention, and thus, an interference situation does not exist.

Claim Rejections – 35. U.S.C. §102

The pending claims stand rejected under 35 U.S.C. §102(e) as being anticipated by the Ferguson reference. It is respectfully submitted that in light of the previous discussion, the

Declaration of Prior Invention Under 37 C.F.R 1.131 is appropriate and should be considered to overcome the cited reference. In view of this affidavit and that the independent and dependent claims further define patentable subject matter over the cited art, assignee respectfully requests that the instant rejections be withdrawn and this case proceed to issuance.

CONCLUSION

For the foregoing reasons, assignee respectfully submits that the pending claims are allowable. Therefore, the examiner is respectfully requested to pass this case to issuance.

Respectfully submitted,

By: 

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